

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Atty. Docket No. 37637-0003

Owner HINTSCHE

Group Art Unit: 1655

Serial No.: 09/142,660

Examiner: B. Sisson

Filed: December 23, 1998

For: DETECTION OF MOLECULES AND MOLECULE COMPLEXES

PRELIMINARY AMENDMENT AND REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This communication is responsive to the Advisory Action mailed April 10, 2001. Applicants filed a Notice of Appeal on February 1, 2001 and now file a Continued Prosecution Application (CPA). Accordingly, a petition for a four month extension of time and the appropriate fee are submitted herewith. Please amend the Application as follows:

IN THE CLAIMS:

Please cancel claims 56 and 57 without prejudice.

Please add the following new claim:

61. A method of detecting a molecule or molecule complex in a diluent, solvent or gel, comprising:

- (a) contacting the molecule or molecule complex with an ultra-microelectrode array, said ultra-microelectrode array comprising at least two electrode structures, wherein the spacing between the electrode structures is less than 1 μm ;

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- (b) producing an alternating electric field between the electrode structures, and
 - (c) measuring changes in current or potential between the electrode structures, whereby the changes in current or potential are caused by the molecule or the molecule complex.

REMARKS

Before entry of the foregoing amendment, claims 21-60 are pending. Upon entry of the amendment, claims 56 and 57 will be canceled and claim 61 will be added. Claim 61 is identical to claim 56, which Applicants have canceled in order to respond to the Examiner's objection to the ordering of the claims. Applicants submit herewith a CPA to remove the finality of the rejection and, accordingly, to allow Applicants to amend the claims, and submit new arguments and evidence as a matter of right.

The Examiner has rejected the pending claims on enablement grounds under 35 U.S.C. § 112, first paragraph. The Examiner additionally rejects claim 57 as being indefinite under 35 U.S.C. § 112, second paragraph. Although Applicants do not acquiesce to the Examiner's indefiniteness rejection, the cancellation of claim 57 render this rejection moot. Accordingly, the only remaining issue is whether the pending claims satisfy the enablement requirement. The Examiner is urged to withdraw the enablement rejection in light of the following remarks.

*** * * * TELEPHONE INTERVIEW REQUESTED * * * ***

Prior to filing an Official Communication in response to Applicants' amendment and request for reconsideration, the Examiner is requested to contact the undersigned Attorney.

Request for Reconsideration:

Applicants also respectfully request reconsideration of the evidence and arguments submitted by Applicants on December 29, 2000, after the Final Rejection. In particular, Applicants request the Examiner to reconsider Inventor Hintsche's Rule 132 Declaration, in view of the enclosed references, which are cited on Form PTO-1449. Applicants also attach a separate Rule 132 Declaration, for the Examiner's consideration, which is executed by both named inventors and is nearly identical to the previous Declaration executed by inventor Hintsche only. Applicants attach a copy of this Declaration as Exhibit A.

Supplemental Response Forthcoming, Which Contains Post-filing Data to Further Respond the Enablement Rejection:

Another Rule 132 Declaration, executed by inventor Rainer Hintsche, will be forthcoming. This Declaration will provide post-filing working examples and will explain how these examples were carried out, using only the teachings in the

specification and conventionally known wisdom at the effective filing date.

Applicants will submit a Supplemental Response in due course, which explains the relevance of the post-filing data to the outstanding enablement rejection. Accordingly, Applicants earnestly request Examiner to consider the forthcoming Declaration before issuing an Official Communication.

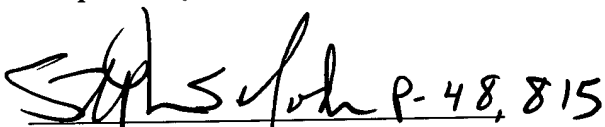
Conclusion

Applicants submit that the present claims are in condition for allowance, and respectfully request consideration to that effect. Should the Examiner have any questions regarding the present application or believe that further discussion will advance prosecution, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,

August 1, 2001

Date


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